

No. 3715

IN THE
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United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT.

Pacific States Electric Company,	}
<i>Appellant,</i>	
<i>vs.</i>	
William D. Wright,	}
<i>Appellee.</i>	

REPLY BRIEF FOR APPELLANT.

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The court at the time of argument of this appeal having granted appellant permission to file a reply brief, within thirty days, the following rejoinder is made to the brief of appellee, and to the oral argument made by appellee in connection therewith.

Woven throughout both the brief and oral argument of appellee, and interwoven with outright misleading statements and references, particularly in the brief, are found two pre-eminent fallacies which may be briefly stated as follows:

First, that claims 6 to 9 inclusive of the Wright patent in suit stand in a generic relation to claims 1 to

5 of that patent, so that, as urged, appellant's device, while not falling within the last mentioned or specific claims, does fall within the first mentioned or generic claims; and,

Second, that in order to establish a defense of anticipation or want of invention as applying to claims 6 to 9 in suit (~~even~~ so far as ^{attempt at} bringing appellant's device within them is concerned), a reorganization of the prior art devices and patented things must be indulged in.

Within the brief time permitted after service of appellee's brief, preparation was made for a partial preliminary attack upon these fallacies by argument. Likewise, in appellant's opening brief, an anticipatory discussion of the second named fallacy was developed to some extent, it having been expected that appellee would resort to that particular line of attack upon the defenses presented. The first named fallacy appellant had not believed appellee could urge seriously or at all, and more particularly because of the clear finding of the trial court (with its only possible ultimate meaning), in the memorandum opinion at Tr. 174, "that the claims should be narrowly construed and should be limited to the precise machine described."

We shall deal with these fallacious contentions of appellee with some further particularity in this brief, and likewise again call Your Honors' attention to the significant bearing upon the contentions of appellee with respect to the alleged scope of claims 6 to 9, of

the search made by the patentee Wright prior to the filing of his application for the patent in suit. This search letter is found at Tr. 215, the sketch referred to therein being reproduced, Tr. 217. As we pointed out on argument, the record is silent and makes no disclosure as to any response to this search letter or to any results predicated thereon.

Again, at this point, we repeat, that as the file wrapper and contents of the Wright patent in suit [Tr. 271, *et seq.*] establishes the fact that the Patent Office did not discover the Simplex electrically heated waffle iron or the Griswold waffle iron with aluminum baking surfaces, or the British Crompton patent, the Wright patent, and particularly claims 6 to 9 thereof, are to be subjected to grave doubt as to validity, for the novelty of the subjects thereof was not tested out in the light of these pertinent and closely fitting prior devices. Obviously, the usual presumption of validity otherwise attaching to these claims 6 to 9 in suit, is entirely dissipated by this oversight on the part of the Patent Office, and Your Honors must perforce consider *de novo* the questions of novelty and validity of the subjects of these claims.

And in this connection, we earnestly offer the suggestion *that the reason Wright did not incorporate in his original application any claims directed to a structure devoid of a base or foundation or grill member or support member* [and he did not, as see Tr. 283-285] was because the response (undisclosed) to

the search letter, of December 9, 1915, *supra*, apprised him of the existence in the art of the Crompton British patent, at least, and likely of the Simplex and Griswold devices, all in evidence. When, however, the Patent Office failed to cite either of these prior devices, or the Crompton patent device, Wright evidently be-thought himself of the possibility of injecting claims (to be construed in accordance with the law of operation of the three-membered device pictured and described in his drawings and specification) and directed at *details of structure*, but not *reciting* the grill or foundation or base member. So he put in claims of this sort, finally obtaining claims 6 to 9, subject, however, to the examiner's statement in official letter of May 31, 1916, Tr. 294, that:

"The application to a waffle iron of an electric heater is not considered patentable broadly, though the specific subject-matter of claims 1 to 5 appears to be patentable. * * *"

As pointed out in our opening brief, Wright accepted this limited view of the invention and his claims therefor, expressed by the Patent Office, and in his response or amendment [Tr. 297] concedes that "applicant's claims are not drawn broadly, but are specific to the structure."

If the claims in suit, or any claim that could be drawn in this patent, were valid at all, it needs must be so only as most specific to the structure, and, assuming the claims in suit represented any inventive act in Wright, the lower court was quite correct in stating,

(as far as the court went), as *supra*, in the memorandum opinion, “that the claims should be narrowly construed and should be limited to the precise machine described” [Tr. 174].

It is not shown in either specification or drawing that Wirght at any time asserted to the Patent Office or published to the world upon the issuance of his patent, any contention or claim for recognition as to any invention other than that which contemplated the employment of “the base or grill member a” [quoting from Wright patent, Tr. 211, first column, line 49] and the employment and inclusion of, at least, the frame or support thereof, to which the two waffle members b and c are separately pivotally joined, and to which base or grill member or the frame thereof said waffle members must of necessity be separately pivotally joined, so that the waffle member b may perform its evolutions, and the complete device may perform in accordance with its closely portrayed law of operation.

In accordance with the clearly established practice in the Patent Office, had Wright intended, or had the Patent Office considered he intended or was attempting to patent any generic combination in and by claims 6 to 9, the same being devoid of limitation to and inclusion of the base or grill member a, we should expect to find some illustration or description, and more properly both, of such essentially different specific form and organization, rather than to find no disclosure whatsoever from which to spell out a structure with such totally different law of operation, as appellee contends for claims 6 to 9.

All Wright's Claims Clearly for One Particular Device.

The law of operation of appellant's device, (which appellee says is within what he calls "generic" claims 6 to 9), with its two casings directly hinged together, as we urged before Your Honors on oral argument, *is abhorrent to the law of operation taught in the Wright patent*, for the device so disclosed in the specification and drawings *could not operate if the lower waffle member b and the upper waffle member c were directly hinged together*. In such case the lower waffle member b could not be swung outwardly beyond the base or grill member a and inverted, and returned over the base member a, as unequivocally called for by the Wright patent.

Can it be that the Wright patent can cover, or be held to disclose or claim, a combination of elements and features (such as in appellant's device), the organization of which is so totally repugnant in mode of operation and action to the clear teaching of the Wright patent? We are perforce constrained, of necessity, and for reasons of mechanical consistency and immutability to conclude that Wright never intended any claim in his patent to be construed so as to include and cover any such device as that of appellant, and that certainly the Patent Office in issuing the patent in suit did not intend to grant and in fact did not grant to Wright any such abortive monopoly. Patents are contracts between the government and the inventor, as,

however, affecting directly the people at large, and are to be construed in the light of the entire contract, and the claims are to be particularly and jealously construed, in order that the public be not prejudiced and embarrassed by interference with industrial pursuits that lie wholly outside of the plain meaning and intent of the contract. No innocent third party (a member of the public) should be held as a tortfeasor for violation of any such contract, obtained *ex parte* unless guilt clearly appears.

It is elementary that the claims must be construed in the light of the specification and drawings, and cannot be given a forced and strained interpretation, which disjoins them from the description and drawings and sets them apart for astute construction to fit the exigencies of an instant litigation.

What we must seek to determine here, in addition to what it was possible for the inventor to add to the art, is what he *actually patented* as an addition to the art. He certainly cannot be legally or equitably held to have patented something that lies without the controlling and solely disclosed and essential mode of operation of the invention, and anything which has a fundamentally different, and, as in this case, a conflicting law of operation, certainly cannot come within the purview of the patent or be an infringement thereof. The factor of operation is as essential as construction in considering what a patent covers. (See appellant's opening brief, page 24 and 26, cases cited.)

Therefore, we contend it clearly to have been demonstrated that claims 1 to 5 of the patent in suit cannot properly be considered, as appellee would have it, as addressed to a *species* falling within a *genus* said to be claimed in and by claims 6 to 9. Webster's International Dictionary defines a genus as "a class of objects divided into several subordinate species;" or, "a precisely defined and exactly divided class;" and also defines a species as "in science, a more or less permanent group of existing things or beings, associated according to attributes, or properties determined by scientific observation." A further definition of species is given, that it is "a conception subordinated to another conception, called a genus, or generic conception, from which it differs in containing or comprehending more attributes, and extending to fewer individuals." It obviously does violence to any genus definition to attempt to bring into it and into its "generic conception" any species, the "attributes" of which are so contrary in nature to the "generic conception" that the necessary action or performance of the genus would render the species useless. *To attempt to group specific things within a classification that would convert the specific things to objects of inutility, would introduce a mode and method of classification obviously as absurd as unhelpful, and utterly misleading.* A species to be of any use must be operative. To attempt to characterize it from a generic standpoint in such a manner as to render it inoperative must of necessity result in excluding it from the generic definition attempted.

And further and beyond all such speculation or demonstration, stands the finding of the trial court that the claims in suit “should be narrowly construed and should be limited to the precise machine described.” With such limitation, the claims can mean but one thing—one exact thing—and that one exact thing, as the trial court says, must be the *precise machine described*. (Italics ours.) The precise thing described, as we have previously observed, must have been overlooked by the trial court, in construing claims 6 to 9 so as to include defendant’s device with the two waffle members directly hinged together. The “precise machine described” is the precise machine disclosed in the drawings of the Wright patent, with its “base or grill member a,” to which the lower and upper waffle members b and c are separately pivotally connected, and which in great detail, and without any alternative disclosure, is set forth and defined in the descriptive part of the specification. All of these three parts, the patentee says, are principal parts of his invention. He says, lines 48 to 50, column 1, Tr. 211:

“The principal parts of my invention are the base or grill member a, the lower waffle member b, and the upper waffle member c.”

Eliminate any one of these and you destroy the entity of the invention, not only in structure but in necessary and required law of operation.

That a sub-combination claim (not present in the Wright patent) to be valid must be for an operative

combination in the construction or operation of the mechanism to which it relates, see *B. F. Slocomb & Co., Inc. v. Layman Machine Co.*, 227 F. 94, 104.

Says the court (p. 104—italics ours):

“That a mechanical device literally falls within the language of a patent claim does not necessarily show that it is covered by the claim. And where the claim is for a combination to be valid *it must be for an operative combination*, and if an element essential to make it operative is shown and described in the patent description and drawings but is omitted from the claim, it must be read into the latter. Each of the parts whose co-operative action is necessary for the performance of the function of the mechanical combination claimed is an essential element of such combination and must have been employed without authority in connection with the rest before infringement can be found. *The facts here do not disclose the case of mere sub-combinations, each having its proper function in assisting to bring about the contemplated general result of the operation of the patented mechanism in its entirety and not so related to, or dependent upon the other parts or sub-combinations as to have its appropriate and distinctive function qualified or modified by their action.* * * * To constitute direct, in contradistinction to contributory, infringement of any combination claim relied on in the reissue patent, it is necessary that the defendant’s mechanism should contain elements the same as, or equivalent to, *all the essential elements, whether expressed or implied*, in the combination claimed

contained in the complainant's machine, *co-operating in substantially the same manner to perform its function.*" (Italics ours.)

The decision in the above Slocomb case was affirmed *on the opinion of the District Court*, by the U. S. Circuit Court of Appeals for the Third Circuit, as reported in 230 F. 1021.

See also *M'Caslin v. Link Belt Machinery Co.*, 139 F. 393. The head note is as follows:

"Where a claim of a patent is for a combination, it must be for an operative combination; if an element essential to make it operative is shown and described in the specification but is omitted from the claim, it must be read into the claim."

In this case the device of the patent included a guard rail. Owing to the presence of the guard rail in the patented device, the court says that there is thereby supplied—

"the means by which the result is attained, namely, the establishment of the overlap of safety * * * owing to the presence of the guard rail."

This case was affirmed by the U. S. C. C. A., Second Circuit, in 147 F. 243.

So it must follow that there is no relation of species and genus as between the subjects of claims 1 to 5 on the one hand and 6 to 9 on the other hand. Nor can there be two species. That would be abhorrent to patent law, for a patent cannot cover two separate inven-

tions—two distinct things constructed differently and having different attributes and laws of operation. Therefore, “the precise machine described” must be represented in but one species, and that species must be the species pictured in the patent drawings and described in the specification, and having all the “principal parts” of the invention, including the base or grill or foundation member a, or its frame, to which the waffle members b and c are independently pivoted, and having a law of operation which *necessarily requires* such independent pivoting of said waffle members.

This attempt of appellee to straddle the defendant’s device by an interpretation of claims 6 to 9 clearly abhorrent to the teaching of the entire patent, is unwarranted within all tenets and principles of patent law, contracts and logic, and flies directly in the face of the findings of the trial court, reduced to finality, that the claims should be narrowly construed and limited to the precise machine described. From the decree based upon this opinion appellee has not appealed. From what we deem error of the lower court in holding that appellant has used the “precise machine described,” appellant has appealed. If the trial court was correct in its limitation of the Wright patent to the precise machine described, (and it can mean only one machine), with which finding, as we say, appellee cannot here take issue, appellee is certainly wrong in his submitting to this court that there can be anything further patented in and by the Wright patent than the

one species or specific thing described and patented in it. Furthermore, we have urged before Your Honors that we do not use the specific thing which claims 6 to 9 are urged by appellee to cover. In fact, the trial court admits differences where the memorandum opinion states:

“It is true as claimed by the defendant that its electrical attachment is fastened to the waffle-irons by screws instead of being contained in a box, but the plaintiff’s device is attached to the waffle-irons, and necessarily so, but not in the same way.” [Tr. 176.]

But we trust to have convinced Your Honors that a more fundamental and entirely controlling distinction between appellant’s device and the Wright patent structure—for which the Wright patent was really issued, as to all its claims—consists in the absolute variance as to construction and law of operation between appellant’s device with its two waffle members directly hinged together, and the Wright patent device with its base or grill member and two waffle members independently pivoted to the same. The distinction is more than obvious; it is mandatory. It excludes defendant’s device entirely, both as to structure and mode of operation, from the teaching and monopoly of the Wright patent.

The artificial teaching and monopoly which appellee would lend to the Wright patent in attempting to make out a generic and specific relation between the two sets of claims, is a mere grasping at a straw, which straw, as a matter of fact, does not exist.

Wright nowhere in his patent specifies that his device, as pictured in the drawing and including the base or grill member, is a mere preferred form or example of his construction. He describes it as the only form. He cannot, even if the opinion of the lower court permitted, ask for a generic interpretation of claims 6 to 9 by attempting to base same on a description in the specification which is specifically limited to a single device, even if he does state in his patent, after describing but one form, that he does not desire to be limited to details. He does not give any hint of any other form, either in drawings or description.

As said in *Excelsior Drum Works v. Sheip and Vandegrift, Inc.*, 173 Fed. 312:

“The defendant’s horn has a band of textile material, which is stretched and glued into a shallow groove that surrounds the horn near the large end, and to some extent this band reinforces or adds strength to the structure. It is therefore within the literal language of the third claim, and must be held to infringe unless the claim should be so limited by the specification taken as a whole and by the state of the prior art as to apply substantially only to such structure as the specification describes in detail. It is the “reinforcing band” that presents the problem here. Should that phrase be restricted to a band of veneering that substantially covers the surface of the horn between the two ends? Or may it be so construed as to cover a single narrow circular band such as the defendant’s, on the ground that the cir-

cular band “reinforces” in some degree? If it were a merely ornamental band, it would certainly not infringe; but the language of the claim, standing by itself, lays hold upon any band as soon as it begins to add strength to the structure, even if the addition be very slight. In my opinion, the claim cannot be permitted to depart thus far from the specification. The description is wholly confined to a thin and narrow band “wound spirally from one end of the horn to the other.” The drawings show this construction and no other, and there is not a word in the specification to indicate that the inventor is merely describing a preferred construction. I think it would be quite inadmissible, therefore, to construe the claim as broadly as the exigency of the complainant’s case requires; and (without attempting to decide what would be a merely immaterial variation from the patented structure so as to expose the maker to the charge of infringement, or to decide precisely at what point the variation would become material so that the new structure would not infringe) I have no hesitation in holding that the defendant’s horn has passed the point that separates the two kinds of variations, and does vary materially. For this reason I hold that it does not infringe.

“It is well settled that claims may be narrowed by limitations in the description (Walker, *Patents*, 4th Ed. p. 173, and cases cited), and, also, that specifications and drawings are usually looked at only for the purpose of better understanding the meaning of the claim (*Howe Mach. Co. v. Nat. Needle Co.*, 134 U. S. 394, 10 Sup. Ct. 570, 33 L. Ed. 963). But whatever reciprocal effect

the description and the claim may in general have upon each other, I do not understand that a broad claim can be based upon a description that is specifically limited to a single device, and does not present it as an example or a preferred structure. A possible explanation of the presence of the third claim is afforded by the file wrapper, which shows that the claim was inserted bodily after various rejections by the examiner, thus introducing the "reinforcing band" for the first time without anything in the description to support language so broad. As originally framed, the specification was drawn to sustain claims that referred only to "a thin narrow band spirally wound about said structure."

So in the case at bar, claims 6, 7, 8 and 9 aim, as interpreted by appellee, to cover something not disclosed, and in direct antithesis to what is disclosed, in a description "that is specifically limited to a single device," and that device is a device which of necessity must have the "principal parts," namely, the base or grill member and both lower and upper waffle members. There is no hint in the patent specification or drawing that any one of these can be eliminated in the practice of the invention. Furthermore, as in the last cited case, claims 6, 7, 8 and 9 were inserted "bodily after various rejections by the examiner," thus introducing the combination of a pair of casings pivotally connected together "for the first time without anything in the description to support language so broad."

Claims very much like claims 6, 7, 8 and 9, as, for instance, the cancelled claim 9, shown at Tr. 292, were

inserted and rejected prior to the insertion of present claims 6, 7, 8 and 9, but broader, and the patentee acquiesced in the rejection of these claims, by cancelling them, thus waiving any claim to the broad idea, that is, to the *pair of waffle members idea*, which, as above pointed out, the examiner virtually held was not applicant's invention when, at Tr. 294, he indicated that the specific subject matter of claims 1 to 5 was the patentable matter, such claims all containing the third or grill or support member. Clearly, the patent was issued with the direct understanding that this third member must be included as a necessary part of any claim, and this must be so to make any claim operative within the disclosure of the specification, for Wright, we repeat, admitted in presenting claims 6, 7, 8 and 9 in the following amendment, Tr. 297, that these claims "are specific to the structure." There was a meeting of minds between the Patent Office and Wright on this matter. Wright is bound by these transactions leading to the issuance of his patent, and particularly so inasmuch as the rule, as announced in *Thatcher v. Transit Const. Co.*, 228 F. 905, is that patentees are bound by their patents, but that the public is not, as patents are procured *ex parte*.

Nor was any change attempted to be made in the specification to introduce matter upon which might be predicated any interpretation of such language as is now urged here by appellee. Had it been attempted, the Patent Office would have branded it as new matter, and required Wright to file a further application if

he desired to patent such new matter. Aside from the limitation of these claims by the trial court to "the precise machine described" (which can mean only one thing) the interpretation urged for claims 6 to 9 is barred by the very specific nature of the *one form*, and its peculiar law of operation, of the disclosure of the description and drawings of the patent; and the absence of any *attempt* to broaden out the specification, when these claims were inserted, so as to lay a foundation for the interpretation thereof now urged by appellee.

Your Honors have recently handed down a prevailing decision which appears to us to be very applicable, in certain of its rulings, to the case at bar. We refer to *Western Well Works, Inc., et al. v. Layne & Bowler, Corporation Appeal No. 3627*, opinion filed October 17, 1921. In that case, it was contended by appellee that the patent in suit disclosed a closed shaft casing having the function of aligning the shaft. The opinion finds that this is not a part of the alleged invention of the claims sued under, and that there is nothing in the claims in suit or specification of patent relating thereto, covering any such aligning action. The opinion says:

"In other words, we are of the opinion that alignment is not a function of any of the elements of either of the claims under consideration."

The opinion further says:

"The function of alignment is therefore dismissed from further consideration."

And the directly hinging together of the waffle members or their casings, in the present case, is equally clearly not a function of any of the elements of either of the claims 6 to 9. And such direct hinging together is not disclosed *at all* in the Wright patent, as to any claim thereof, or otherwise.

The court limited the Layne patent to its clearly disclosed essential mode of operation, involving the stagnant lubricating system, and, finding that defendants followed the prior invention of Jackson as to a circulatory lubricating system, reversed the decree of the lower court with instructions to dismiss the bill.

Our teaching here is also entirely that of the prior art, both as to structure and operation.

Re-organization — None Required Over Prior Art to Produce Appellant's Device—Revolutionary Re-organization Required to Convert the Complicated Three-Membered Structure of the Wright Patent (His Only Possible Invention), Into Appellant's Device.

The situation here is quite analagous to that in *Henry v. City of Los Angeles*, 255 F. 769. There Your Honors found no infringement made out, the mechanical structure of defendant being found totally different from and not equivalent to the electro-magnetic-mechanical and highly complex (and not commercially adopted) construction of the Lyndon patent in suit. As we have pointed out, the complicated articulated structure portrayed in the Wright patent has

never gone into commercial use. Wright has made no commercial use of the invention or of anything contended to contain it. The real appellant, following its prior specific practices in electrically heated apparatus, such as portrayed in the several Lamb patents, in matters of detail structure, and directly employing as a complete frame work and organization, the prior art as exemplified in the British Crompton patent, has taken the field and succeeded. In so doing, it has not utilized the complicated structure or organization, or teaching, of the Wright patent in any respect.

This proposition of “re-organization” applies of course equally to contrasting the patent in suit with the prior art, and to contrasting the defendant’s device with the patent in suit—just as, and for the same reason that, the question of anticipation is related to the patent in suit in the same manner as is the question of infringement, it being clearly established in patent law that what would infringe would by the same token anticipate, and vice versa.

Appellee has had considerable to say in his brief about the court being robbed of recourse to imagination for the purpose of producing the *alleged* invention of claims 6 to 9 of the Wright patent as a step over the prior art, it being urged that as the *alleged* invention has been produced and its entity conceived and put before the world, the court can not go through those mental processes attending its creation which the patentee went through in the act of creation. This is a very pretty theory, and it may perhaps fit the facts and cir-

cumstances if the invention here be properly considered to be the complicated thing his specification and drawing really disclose. In either case, however, the rule stands that an alleged inventor is deemed to have before him all other prior devices and patents when he attempts or performs his alleged creative act, whether he has actual knowledge of such prior art or not, as the Supreme Court said in *Duer v. Corbin Cabinet Lock Company*, 149 U. S. 216; 37 L. Ed. 707, quoted from in our opening brief, pp. 31-32. So let us, in the instant case, set the table of the prior art, up to which Wright is presumed at law to have drawn his chair, to partake of the food required to quicken his brain to inventive performance.

On that table must be found the Simplex device, (the electrically heated *waffle iron*), the Griswold device, (the waffle iron with the aluminum baking surface), the Crompton British patent electrically heated culinary device, the Capek patent device, and the prior culinary articles, electrically heated—a whole line of them—put out by the defendant corporation Landers, Frary and Clark, and including in their structure, as does defendant's device at bar, the patented improvements of Lamb, relating to the construction of the heated and heating and insulating features. Now, among all of these devices we may truthfully assert that the Simplex electrically heated waffle iron may properly be regarded as the "generic" structure, within which fall the Crompton device, and

defendant's device—and what appellants^{ee} urge to be the thing patented by claims 6 to 9. When we come down to species, we find that the Crompton patent device (with the aluminum baking surface of the Griswold waffle iron) is the species of the genus adopted for practice by defendant, the same being in detail modified to utilize the unitary construction of baking surface and heating element and insulation invented by Lamb and previously used by the real defendant here.

In so far as the Wright patent applies to waffle iron practice, the species disclosed in that patent lies at the very boundary line of the Simplex device genus, for it is dependent in operation and use upon the inclusion of the base or grill member, (a third element indispensable to the Wright invention), and is a distinct variation from the species that includes Crompton and the defendant. Wright went off on an independent line of development, and devised a complicated *three-membered structure*, falling, perhaps, questionably within the genus of the Simplex electrically heated *two-membered* waffle iron; but defendant indulged in practice true to the main characteristics of the genus, and followed the *two-membered practice*, taking bodily the Crompton organization, and merely modifying it (*not reorganizing it*) *in details*, but not at all in substance. Of course, defendant is presumed equally with Wright to have had the benefit of all prior art devices, in producing and standardizing defendant's structure. And defendant followed closely in practice what was well known in the prior art, and steered away from the

unadopted and commercially ignored three-membered structure of Wright.

It certainly required less “re-organization” on the part of defendant to follow closely as it did the prior art Crompton teaching, than it would require, on the one hand, to make over Crompton or Simplex into the complicated peculiarly operating structure of the Wright patent, or, by the same token, to make over such latter complexity into the opposedly different defendant’s device, considering the latter both structurally and as to its operation.

By every test that can be applied to the prior art, defendant followed such prior art in its practice and did not follow the marked variation of species (perhaps within the Simplex genus) evidenced by the complicated Wright patent accomplishment. Defendant is presumed to have drawn up to the same table upon which were displayed the prior art devices, when defendant standardized its waffle iron device. It is clear that it picked out what was old in the art in all detail and in all essential completeness of organization. Wright must have done the same thing, omitting the Lamb features above referred to and selected and used by appellant, if we adopt the interpretation he asks for claims 6 to 9. Upon the interpretation he asks, these claims are void for want of novelty.

But the proof to the contrary, as to Wright’s procedure, stands, that his whole teaching is of something not to be found on that table, and which defendant does not use, to wit, a combination of base member,

and two waffle members each separately pivotally mounted upon such base member or grill member, to provide for peculiar evolutions and different uses of one of the waffle members. It required no re-organization over the prior art to produce defendant's device, or to produce the hypothetical device which appellant claims and the lower court found was covered by claims 6 to 9. Therefore these claims must be anticipated or devoid of invention in so far as they relate to defendant's device, (which, of course, we contend they do not.) It would take the highest inventive skill to re-organize the *real* Wright device to product defendant's device. No aid or assistance in that direction is proffered by the drawings and description or any other part of the Wright patent. So defendant should be discharged of the claim of infringement, for its path from the prior art is a direct one and not the circuitous one that leads to and through the Wright patent.

If we refer to the Crompton patent drawing [Tr. 171], we will find in Figure 5, which is a side view of Figure 4, (and *not* a detail of the "lid" of Figure 3), what is the upper portion of a heating appliance, which the specification clearly indicates at Tr. 170, is to be one of two directly heated surfaces, both formed alike. If, we submit, Figure 5 is closely inspected, it will be found that the casing is shown in fragment at the left hand side, projecting below the resistance material and insulation, which is clearly shown in Figure 1 and Figure 2. This indicates clearly that the upper member of the culinary apparatus is to be constructed like

the lower member. It, of course, would be inverted when applied over the lower member and connected with the same by the hinge members such as clearly indicated in Figure 1 and Figure 3.

The "lid" of Figure 3 is a separate hinged attachment and is not the upper member of a device organized as last described, in which the construction of Figure 1 would be duplicated to produce the upper member (of Figure 5), and constitute the patentee's construction where he states: .

"In some cases we prefer to use two directly heated surfaces, both of which may be formed as above,
* * * "

Clearly, Crompton sets forth four types or combinations, to-wit: One, organized as last described;

Second, using merely the lower electrically heated member and his pressure plate which need not be directly heated but which is organized like the lower member;

Third, using only one heated surface organized like the lower member; and

Fourth, using the lower electrically heated member and an electrically heated lid or cover such as shown in Figure 3.

Surely, Crompton's disclosure is full and suggests many different forms (which the Wright patent does not), and one of which forms, that above first particularly described, is closely followed by defendant, *even down to the flanged baking surfaces, the flanged*

edges extending over the edges of the casing or screen, the screws holding the baking surfaces of the waffle member in the casing or screen, insulation and resistance medium below the baking surface, the legs for the casing, the service wire connections, the direct hinged connection of the two waffle member casings, and everything except the particular application of heating medium and resistance to the baking surface as devised by Lamb and used by defendant in prior devices, and the aluminum baking surface itself, with its well known properties, well known in the art, in the Griswold waffle iron.

In this connection, we here quote from this court's opinion (filed October 3, 1921) in *Majestic Electric Development Co. v. Westinghouse Electric & Mfg. Co.*, Case No. 3617:

“Counsel for complainant claims for the invention a broad construction on the postulate that the patentee was the first discoverer of what he terms the “radiant energy beam” and that the invention is suited to the producing of such a manifestation of radiant energy—

If the patentee was, in reality, the discoverer of this principle, he has made no claim to it, either in the specification or in the claims of his patent. The only elements from which the inference may be drawn that the reflector is in the form of a parabola are that the drawing would seem to be of that type, and the claim that the heating unit is to be at the focus, or substantially so; there is no suggestion respecting its effect in physics, in

casting a cylindrical shaft of radiant energy from a heat-producing unit so positioned as indicated by the claim”—

(This as to the silence of the Wright patent as to defendant's structure and operation.)

Then the court reviews the prior art, saying:

“However this may be and whatever may be the concept *as to the function to be secured*, the device, in either sense, is not one that is new in the art”

stating as to one prior art patent, for instance:

“While the use sought to be made of the device was not the same as the use to be made of the one in suit”—

The court relies on an *English patent* as affording a “disclosure of the dominant idea”—Crompton, British patent, is surely a disclosure of the dominant idea of what appellee contends claims 6 to 9 cover. The claim in issue was:

“An electric heater, comprising a concavo-convex reflector, a heating unit supported at substantially the focus of said reflector, an annular member extending outwardly from the margin of said reflector, and a protective cage having guard wires arched between opposite sides of said annular member.” (Italics ours.)

To go somewhat further into detail, which will perhaps be helpful, let us observe that plaintiff-appellee attacks this Crompton patent mainly because he claims that as shown in the drawings its hinges appear too high or too long, that the Crompton specification does

not specify *aluminum as the material* for the heated or cooking surface, that the drawings do not clearly show a *duplicate of the device of Fig. 1* hinged to that device, and that *the patent is an old one*. Counsel failed to point out wherein lay the exercise of inventive faculty in curing any or all of these alleged defects or deficiencies, all of which are most trivial. It is pure hyperbole to consider them as of any serious damaging effect.

(a) *The Crompton Hinges*: The drawings plainly show, but diagrammatically show, the position of the hinges. No description ties the mechanic to the special proportion shown in the drawings. If one is to use the Crompton apparatus for the “culinary” purpose of electrically cooking meat between two electrically heated surfaces hinged together, obviously he would make the hinges to accommodate the meat to be cooked. If he were to make the Crompton device for the “culinary” purpose of cooking “pudding” (specifically mentioned by Crompton and akin to waffle batter), obviously he would proportion the hinges to properly accomplish that result. By no stretch of the imagination could such accommodation of the hinges to one material or another be considered to require more than the skill of the mechanic skilled in the art. Moreover, the Simplex waffle iron, which is itself an electrically heated waffle iron, has properly proportioned hinges for the purpose.

Wright, in his patent, in addition to failing to teach *direct* hinging, makes no specific disclosure as to just

how the hinges shown are to be made to be of the proper proportion. That is left to the mechanic skilled in the art precisely as Crompton leaves it.

(b) Crompton does not state specifically of what *material* his heated or cooking surfaces are made. That leaves it open to a mechanic skilled in the art to take any material adapted for the general purpose of cooking by such a “culinary” apparatus. Before the time that Wright came into the field waffles had been cooked on heated surfaces of both iron and aluminum. Therefore, as the mechanic is not tied down to any particular material by Crompton, the field is open to him, and aluminum being in that then well known field it certainly only required the skill of his art and not inventive genius to use aluminum with its attendant and inherent advantages, whatever they may be.

(c) We submit that no amount of hair-splitting argument could make it require a stroke of inventive genius, in view of the Crompton disclosures, or even without them, to duplicate Fig. 1 for cooking waffles according to the old Simplex method, for instance.

(d) *Age of the Crompton Patent*: This has nothing to do with its effect on the Wright patent. Its teachings are perfectly clear. Crompton’s date is 1893, some 23 years before Wright applied. In the case of *Brill v. Washington R. & E. Co.*, 215 U. S. 527; 54 L. Ed. 311, 315, the U. S. Supreme Court had before it a patent for improvements in car trucks, particularly for electric street railway cars. One of the prior art

patents set up in that case to limit or invalidate the Brill patent in suit was a British patent of 1845 to Thyng. Apparently similar criticism was made of this Thyng patent as is made in this case of the Crompton patent as to its age. On this point the Supreme Court says (p. 315—italics ours):

“It is said that the Brill patent did not follow the Thyng invention *for more than fifty years*. The answer is that for most of that time it was not wanted. Very soon after the change in street railway travel required it, it came.” (Italics ours.)

So in the case at bar, Crompton was not wanted until the conditions were right for it, then it came.

The vigorous attack through such trivial objections to Crompton only emphasizes its pertinence to the issues here involved, which must be recognized by all concerned.

The Crompton model used at the argument, as an illustration of the construction shown in the Crompton patent, is helpful. Inspection will show that it carries out precisely the construction disclosed by Crompton in all essential particulars. It shows the box-like casing with its supporting legs and its socket for attachment to the electric circuit. It shows, placed in the box-like casing, insulating material, then the very thin flat resistance wire that does the heating, embedded in insulating material, with insulating material above said wire and the heated or cooking surface resting on the upper edges of the box-like casing *by flanges* extending outwardly from the heated or cooking surface, with

all parts held together by screws, as shown in the drawings of the Crompton patent.

Where courts have failed to rely on foreign patents as defenses it has been where such patents were obscure; not as in the Crompton patent, where they are clear.

Appellee's brief has a great deal to say about Wright inventing a smokeless and greaseless waffle iron surface. He did not. Likewise, appellee has much to say about Wright inventing a waffle iron which can be placed upon the dining table and used on the house circuit. He did not. Nor does he lay any claim to any such structure or invention in his patent, and he cannot patent *mere results*. He only states that aluminum cooking surfaces obviate the necessity of lubrication, which was well known in the art, being true up to a certain temperature. That was utilized in the art in the Griswold iron.

Everything of any organization that Wright now contends he patented in and by claims 6 to 9 is found in Crompton, save and except what Wright *did not invent*, to wit, the use of aluminum baking surfaces—unpatentable material old in the same art—and the specific heating and insulating features, devised and used by defendant, not by Wright.

Appellee's counsel at the hearing and in his brief attempts to magnify the simple mechanical expedient of the flanges on the heated or cooking surface by ascribing subtle and unexpected uses or functions to the flanges. As matter of fact, whether in Wright or

in defendant, the flanges are the purest mechanical expedient. Whatever they do in Wright, they had already done in Crompton. It is an obvious mechanical expedient for finishing the upper edge of the box-like casing of Wright and of Crompton. They cover the casing so that nothing that is being cooked drips down into the box. If made of aluminum, as they could be made without recourse to Wright, they prevent sticking of the batter as they would prevent sticking of the batter if made of iron and greased. The painstaking effort to enlarge the importance of the Wright flanges utterly fails of effect in view of the presence of the flanges in Crompton, with all their resultant and incidental functions.

Attention is here called to a very pertinent decision in *Adv. Sheets Fed. R. of Oct. 20, 1921; 274 Fed. 612, Troy Wagon Works Co. v. Ohio Trailer Co., C. C. A. 6th Circ.*, as to prior art, foreign patents, want of invention and no infringement, and also mere mechanical skill.

With all the prior art before Wright, as we have seen it must be presumed to have been, it involved absolutely no imagination or creative effort to produce the device which appellee *contends* claims 6 to 9 of the Wright patent cover. To produce the intricate and peculiarly operating and never commercially employed three-membered device the Wright patent discloses and was issued for, may, perhaps, have required some sort of inspiration. But this organization has been entirely ignored by defendant, who, and not Wright,

has given the public the modern commercial type of electrically heated waffle iron. Whatever, in commerce, Crompton may have done in England we are not concerned with. In this country the defendant has taken the field, and has certainly not done so with the Wright invention.

In further reference to the opinion of the lower court [Tr. 176], we wish to observe that the reasoning employed, with respect to appellant's contention, that if appellant uses a screen or cover it should devise something else, seems to be entirely out of line with the conclusions reached. If, as appellant contends, it does not use a *box* (although Crompton clearly has it in the prior art) it would not seem that there should be any reason for appellant to devise something else. If he uses a screen or cover and not a box in the sense of the Wright patent, that in and by itself is a further reason to find non-infringement under any interpretation of claims 6 to 9. The court, having limited the Wright patent to the "precise machine described," appellee, under any possible interpretation of the claims, is not entitled to receive indulgence under the doctrine of equivalence.

Specific Reply to Untrue, Erroneous and Misleading Portions of Appellee's Brief.

We beg the indulgence of Your Honors in our replying to and criticising specifically certain portions of appellee's brief, although the preceding portions of this brief and our oral argument have dealt with the general aspects of the same.

On page 9 certain discussion is had of the benefits of using casings of pressed steel. Obviously these casings would radiate heat more readily than thicker porous cast metal casings. But the same kind of casings are found in Crompton.

On page 10 appellee attempts to make it appear that the flanges of the baking surface support the baking member. They may do so in defendant's device, but they do not do so alone, at least, in the Wright patent device.

Referring to page 24, appellee indulges in a discussion of what claims 6 to 9 mean in the use of the language "pivotally connected together," referring to the casings. As we have seen, this can only mean that the casings are pivotally connected together *through a grill or base or foundation member*, for otherwise the device of the Wright patent would be clearly inoperative, and this base or grill member is one of the "principal parts" of the Wright invention. Indeed, within the language of the Wright patent, and its drawings, if either the base or grill member or the lower waffle member or the upper waffle member be omitted, *the entity of the patent is destroyed*. Particularly, should the base or grill member a be omitted, or the grill member c be directly pivotally connected to the grill member b, the device would be absolutely unusable. That being the case, there is no possible proper interpretation of claims 6 to 9 other than one which includes the base or grill member a or its frame, as the means for pivotally connecting together the

waffle members b and c. Appellee states that the phrasing of claims 6 to 9 includes both the pivoting together through a grill member or pivoting directly together. But, inasmuch as the device cannot operate in the latter case, appellee's assertion and argument are false on the very mechanics of the case.

Apart from Crompton, which meets each and every feature of claims 6 to 9, in so far as, under any interpretation, they could apply to defendant's device, with the exception of the use of the old Griswold aluminum baking surfaces, the statements of appellee as to what Wright did are entirely erroneous when consideration is given even to the Simplex electrically heated waffle iron which has a pair of hingedly connected casings with waffle baking members mounted therein, in lieu of the old circular stand and revolvable pan type of waffle iron, (p. 8 appellee's brief). Within these "casings" of Simplex are resistance and insulation.

Opposing counsel seemed to desire to lessen the effect of this Simplex iron on the ground that it was not specially explained at the opening argument. It is fully set out in appellant's opening brief. Its construction and mode of operation are so obvious on inspection of the device itself (Defendant's Exhibit No. 1) that the Simplex device divests Wright of all broad novelties for its specifically and electrically heated waffle iron. Its size and make-up are of no moment. Size is no feature of the Wright patent and nothing disclosed therein makes his patented device especially

adapted for table use any more than the Simplex device, as will be seen by a comparison of Simplex with either of Wright's early models. While it is true that Wright describes aluminum as usable in his device, Simplex, in view of the prior Griswold waffle iron, could substitute aluminum for iron if desired without appeal to Wright, and the Simplex stand could be reduced in size accordingly without appeal to Wright. Wright's device showing his patented construction was not of a size adaptable to actual dining table uses in the sense that defendant's device is. There is nothing in the claim that Simplex takes more heat than is available on a lamp socket line. The amount of heat required is dependent upon the amount of resistance wire that is put into any of the devices plus current wattage. That special amount is not disclosed nor claimed by Wright. That is left to the choice and judgment of the mechanic skilled in the art. The Simplex iron also shows hinges adopted for waffle cooking, if that is of any importance.

In view of Simplex, Wright was not the first to tell the art that waffles, specifically, could be cooked by electricity. Simplex had already accomplished that and had done it by hinged electric cookers inclosed in casings and with hinges of a size or length so that the irons would fold flat on each other and keep the batter in. Wright simply *professed* to disclose a new structure or way of making a waffle iron in combination with a grill member.

On this page 24 and the previous page appellee finds considerable fault with the Crompton device as having

too long hinged members. We are not advised that the alleged invention of Wright produced any superiority or reflected any ingenuity as regarding the length of hinge members. The functions and uses and results of a thing, new or old, cannot be patented. It is pure nonsense for appellee to discuss the advantages of particular current wattage, appearance and convenience, as fitting a waffle iron for table use. We do not believe the device of the Wright patent, as exhibited, would be chosen by any housewife to put upon a dining table. As to the impropriety of laying claim to function, result, principle and the like, the courts have repeatedly disapproved such contentions on the part of patentees, as in the decision of the Supreme Court, *O'Reily v. Morse*, 15 How. 62, 112, 14 L. Ed. 601, 623. (And to the same effect see *Morton v. New York Eye Infirmary*, 5 Blatchf. 116, Fed. Cas. No. 9865.) In the *Morse* case, the attempt of Samuel F. B. Morse, the inventor of the telegraph, to cover the "principle" of using as motive power the electric or galvanic current *with the result* of marking or printing intelligible characters at a distance, was condemned, and the claim of his patent purporting so to do was found void.

Plaintiff's counsel, looking at defendant's device, emphatically attributed to Wright the first disclosure of an electrically heated waffle-iron device to be operated on a table, that is, we presume he meant on an ordinary dining table at which a meal is being served. Counsel failed to point out so far as we can judge what

there is about the structure recited in the Wright claims in issue that insures it as a success for table cooking as compared with Crompton or other prior art structures. Certainly the device that Wright puts in evidence as an embodiment of his invention is a poor make-shift for a table cooker. His patent gives no clue as to the proportions or sizes that make it best of all for such table use. Certainly there is nothing in his claimed elements of mechanical structure of box-like casing, with the materials in the order named placed in them and the flanged cooking surface on top, that is not fully disclosed in Crompton, to say nothing of other prior art. If it is the employment of aluminum that solves the riddle, Wright, as we have seen, is not entitled to be accorded a monopoly in electrically heated waffle irons because of his having mentioned aluminum as the material for the heated or cooking surface. That was old in the art before him. Certainly no disclosure is made in Wright as to the amount of current that is to be used. Of course if Wright is going to cook many waffles at once, as one of his exhibits shows he intended to do, he must use more current than if he only cooks two waffles at once. But his patent does not reveal any disclosure of structure or combination of elements that restricts him to a pair of waffles to be cooked at one time. It does not reveal any detail that is to be relied on, or is essential to adopt, in order to affect the amount of current required. No single feature, nor all the features of Wright in combination, results or result in mere ornamental table waffle cook-

ing. It is true defendant's device might be so used, but that results not from any novel disclosure by Wright, or any teaching in his patent that any novelties of structure disclosed by him are necessary for making the table cooker, or that any departure from them would result in failure. There is absolutely no merit in the "for table use" argument of plaintiff.

In *Carver v. Hyde*, 16 Pet. 513, the Supreme Court said that the end to be accomplished is not the subject of the patent. The invention consists of the new and useful means of obtaining the end.

In *Corning v. Burden*, 15 How. 252, the Supreme Court said that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produced it.

Wright devised no new construction which has been appropriated by defendant. If his three-membered device (which we doubt) is economical in consumption of electrical energy, and is pleasing in appearance and use on a dining table, it never has met with public adoption, which would seem to speak louder for its demerits than appellee can speak by brief or argument for any merits it possibly may have. It stands today idly by the wayside. The practical part has not paid it any recognition.

On page 32 appear some outright misstatements in dealing with the Crompton device. The Crompton device obviously *does disclose* fairly a pair of casings pivoting of the surface being immaterial) and *does show*

waffle members mounted in the casings (the mere patenting of the surface being immaterial) and *does show* such waffle members with flanges covering the upper edges of the casings, whether they be of aluminum or any other metal. With Griswold's teaching, this use of aluminum by defendant was optional and Wright was not the first one to teach it.

On page 33 appellee makes it appear that we have suggested that certain other patents and devices "might, by a process of modification, re-organization, or combination with each other, be made to accomplish the function performed by the device of the patent sued on," but we have made no such suggestion, although appellee purports to quote our language. We have stated to the exact contrary, that *no modification, re-organization or combination is required to apply the Crompton device to our purposes, but that complete modification, re-organization or combination* of the parts and features of the Wright patent disclosure would of necessity be required to build up defendant's device.

Lower on this page 33, appellee creates an entirely erroneous impression and one totally unwarranted by the record, as see petition to reopen case and notice thereof, [Tr. 162] and affidavit of Raymond Ives Blakeslee [Tr. 164]. Defendant's counsel never knew of this Crompton patent until during the trial of the case. Appellee would make it appear that we did know of it before and did not discover any resemblance between the Crompton patent and the Wright invention

until after the trial, and then resorted to it in desperation. But the record makes clear what really occurred. It is true that there is no resemblance between the Wright patent disclosure and the Crompton patent as to general organization; the resemblance is between Crompton and what appellee contends for claims 6 to 9, in so far as it could apply to appellant.

At the bottom of page 33 is an argument for the re-patenting of old things. Anything that was in Crompton certainly could not be again patented by Wright.

On page 41 appellee observes that the Simplex iron will not perform the functions of the Wright iron and is more expensive in manufacture. It certainly will electrically cook waffles and we doubt whether it is as expensive to manufacture as the complicated many-pivoted, link-connected, subject of the Wright patent.

On page 42 appellee makes some very sweeping statements which are not borne out by the facts, inasmuch as even the Simplex device has the box-like formation, the folding casings being hinged together in pairs. What the flanges have to do with the folding over of one casing on the other we cannot understand. This was old in Crompton.

On page 43 appellee opines that it is much easier to add than to invent. If Wright invented anything it certainly did not *add* anything to the useful arts, as far as public adoption is concerned. If any adding has been done by defendant, it has been entirely outside of the calculations of Wright.

If, as appellee states on page 48, the Wright invention comprises a new combination of elements and serves a new function, not met by any prior patent or device, we must conclude that this is predicated upon the exact three-membered device which is the only thing disclosed in the patent.

For the purpose of this case, Wright may be allowed the monopoly of his claims 1 to 5. To concede to him what he asserts for claims 6 to 9 would be to wipe out of the prior art and the record thereof in this case what defendant employs and what Wright did not contribute to the art. Within the authority cited on page 49, we can, in the case at bar, leave appellee the “jewel” (if it ever receives public valuation) depicted in his drawing and described in his specification. From the public viewpoint the “jewel” of value is that thing not invented by Wright, but which defendant put on the market.

A direct distortion of testimony appears on page 50. Being convinced that it cannot accurately be said that an aluminum waffle baking member is mounted *in* each of the casings or any casing of defendant, appellee attempts to convert the testimony to an admission in that behalf. He says that the admission is that the member is “mounted in.” The testimony, as appears immediately after in answer to X Question 131, says “mounted on.”

A little further down the page, appellee says quite accurately that an electric heated element is “annexed” to the under side of each of the waffle-baking members

in defendant's device. But in the Wright patent the heating element is not *annexed* to the waffle member at all, but is between the waffle member or the aluminum baking surface and the bottom of the casing. No indication is given in the Wright patent as to the means employed to hold the waffle member in the casing and over the insulation and heating element which is apparently closely confined beneath it, and upon which it rests.

At the bottom of page 50 is a clear departure from mechanical fact and distortion of relations. Defendant's heating element is certainly not *between* the waffle member and the casing in the sense of the Wright patent, but is *on* the waffle member and definitely spaced from the bottom of the casing. In the Wright patent, the heating element is closely confined in insulation between the bottom of the casing and the waffle member.

On page 51 appellee gives a peculiar and, it would seem, obsolete definition of the word "mounted." A better definition would seem to be that of Webster's International Dictionary, to wit, "placed on a suitable support or fixed in a setting. * * *" Each of these parts of the definition signifies a *superimposed* relation. A stone "fixed in a setting" is "mounted" on the ring. It would be a strained and peculiar use of the term to imply in its use that the mounted thing was *in* an enclosing structure, and such meaning could not naturally follow unless a clear limitation to such en-

closed relation were defined. Wright does this in the patent by providing specifically that the waffle member is *in* the casing. Of course in the Wright device the waffle member is mounted *on* the insulating and heating element which are *on* the bottom of the casing. This sort of mounting is not found in defendant's device at all. In Wright's patent the aluminum baking surface is mounted *in* the casing, and is mounted on the insulation and electric element which are in turn mounted on the bottom of the casing. This accounts for the distinction in these matters, which the trial court found, where the opinion observes that defendant's electrical attachment "is fastened to the waffle-irons by screws instead of being contained in a box, * * *" This is the particular difference in which defendant, following otherwise the teaching of Crompton, *reorganized* the heating element and its insulation and the *mounting* of the baking surface, or waffle member, and in doing so did not follow Wright. Remembering that appellee is barred from resorting to the benevolence of the doctrine of equivalence and is limited to the "precise machine described," claims 6 to 9, even with the most favorably improper interpretation, cannot be infringed.

Defendant uses in these respects simply what it had used in the same general art before.

Counsel is in error in apparently attempting to have it understood that defendant's device is primarily made up of a pair of casings hinged together. In Wright

the casings are of essence, because, as in Crompton, they receive and contain in themselves all the other parts of the waffle iron. In defendant's structure, as the court will see, the waffle iron itself has mounted on it (is equipped with, if you please) the insulating material and the heating wire. This is different from Crompton; this is different from Wright. That is like the Lamb, L. F. & C. stove. That is a different mechanical conception of how to organize an electrically heated waffle iron, or any electrically heated cooking surface. Crompton and Wright both had the idea of using box-like casings in which all the other parts were assembled and piled up from the bottom. Defendant, departing from both Wright and Crompton, attaches its insulating and heating parts directly to the bottom of the waffle iron itself. What are called the "casings" in defendant's device are only so in name. They are not so in the function of casings of the Wright patent or of Crompton. If, therefore, Wright is to be considered, as he must be, as disclosing *casings* that contain, he is fully met by Crompton. If, to try to avoid Crompton, he resorts to trivial and non-essential differences, he restricts himself immediately to features not present in defendant's device. Defendant in making its waffle iron simply followed its own prior practice in making the Lamb electric stove. That is, took a flanged heated or cooking surface to the bottom of which it attached the insulating material and resistance wire, and then placed a sheet metal cover or screen about them to cover their unsightliness and to

protect the leading-in wires. In the case of the Lamb stove the casing happened to be round in shape instead of rectangular as in Wright, but Wright in his patent states specifically that his device may be of any shape, so shape is not material.

On page 52 appear some very distorted reflections of defendant's device. Clearly, in defendant's device, there is *no* non-conducting or insulating element spacing the electric heating element from the casing, nor is the metal plate confining the heating element and insulation primarily supported by the casing; nor do the mica pads of defendant's device, together with the plate, insulate and separate the electric heating element from the casing; nor do these features find their counterpart in the Wright patent disclosure in performance or function; nor are the said elements of defendant's device supported "in the casing by the casing," in the sense that the Wright baking surface and heating and insulating elements are "mounted" *in* the casing; nor do similar results—that is, as to function—produce equivalence; nor can defendant's device operate the same as the Wright patented device operates. The matter on the following page is not established in mechanics. The thin steel casings would radiate and waste more heat than thicker casings, increasing dissipation. Other features of advantage set forth, whether correctly or incorrectly stated, were not Wright's contribution to the art. Wright's conception was not generic but very specific, and defendant does not follow it. That would be true even if

Wright had patented a two-membered waffle iron. We have discussed the opinion of the court and pointed out the apparent error of reasoning therein based upon the court's own narrow interpretation of the claims in suit. Even giving them the interpretation asked by appellee, they should be limited to the exact thing of the drawings and specification. The part of the opinion quoted from on page 54, in all substance, as truly, and more truly, applies to a comparison between claims 6 to 9 of Wright as construed by the lower court, and the Crompton device. Again, what would infringe if later, must anticipate if earlier.

If the court will consult the citation on page 54, from 263 Fed. 577, 580, the following language, which gives a much truer complexion to the quoted matter, will be found on the same page:

"A patentee may describe something that he does not claim or claim that which he has not described. His grant of privilege is construed to cover only that which is both described and claimed, no matter how broad the claim language may be. *Loraine, etc., Co. v. Gen. etc., Co.*, 202 Fed. 216, 120 C. C. A. 615, *Lovell v. Seybold, etc., Co.*, 169 Fed. 288, 94 C. C. A. 578. Description may limit a claim, which must always be read in the light of the prior art. (A phrase amplified in *Pelton v. American etc. Co.*, 239 Fed. 321, 152 C. C. A. 308); but it can never expand it. (*Fowler v. McCrum, etc., Co.*, 215 Fed. 909, 132 C. C. A. 143.) So that a patent (ie. a claim) can never be given a construction broader than its terms in

order to cover something which might have been claimed but was not. *Universal, etc., Co. v. Sonn*, 154 Fed. 665, 83 C. C. A. 422.

“The drawings may help out an ambiguous description, but never can they supply the entire absence of any written description of a feature of the invention (*Windle v. Parks*, 134 Fed. 381, 67 C. C. A. 363);”

In this last cited case, which inspection shows to be entirely contrary to the trend which appellee would give it in the fragmentary quotation, the decree of the lower court finding infringement was reversed. And it is obvious that that case makes it clear that one cannot lawfully claim by patent what is not clearly described. And Wright makes no description of any device devoid of his three “principal parts.” Obviously, claims 6 to 9 must have read into them the construction and law of operation of the patent, which involves the use of the base or grill member a, or foundation member, as the means through which the pair of casings are pivotally connected together.

That the claim must be construed wholly within the light of the description is further laid down in *Homar Brooke Glass Co., et al. v. Hartford Fairmont Co.* (C. C. A. Second Circuit) 262 F. R. 427, 430, a case in which a decree for defendant was affirmed, as follows:

“Whether Mr. Brooke’s invention is of such a primary nature as to merit the application of the word ‘pioneer’ we shall assume, but not decide;

for whatever the proper adjective applicable to this patent, the legal rule of construction is the same. *Outlook etc. Co. v. General etc. Co.*, 239 Fed. 878, 153 C. C. A. 5, *et seq.* It is always necessary, even after granting the widest range of equivalents, to find as a matter of fact that what the defendant has done is the invention of the plaintiff 'substantially as described.' The range of decision, the limits imposed by law on the triers of the facts, are indicated by the word 'substantially'; an infringer may easily substantially imitate a big thing—i. e., a deeply rooted and wide-spreading inventive thought; whereas, without 'Chinese copying,' imitation of a little thing is oftentimes difficult.

"But, whether the invention is large or small, primary or trivial, it remains true that, when a claim is clear and distinct, the patentee cannot go beyond the words thereof for the purpose of establishing infringement; the specification may be referred to for the purpose of limiting, but not of expanding, a claim, and the range of equivalents is measured by what is described *and* claimed. *Westinghouse, etc., Co. v. New York, etc. Co.*, 119 Fed. 874, 56 C. C. A. 404; *Universal, etc., Co. v. Sonn*, 154 Fed. 665; 83 C. C. A. 422; *Loraine, etc., Co. v. General, etc., Co.*, 202 Fed. 215, 120 C. C. A. 615; *Fowler, etc., Co. v. McCrum, etc., Co.*, 215 Fed. 905, 132 C. C. A. 143."

(Italics appear in text.)

On page 55 there is a clear misstatement as to claim 6, reading upon the specific embodiment of the Wright

invention illustrated in the drawings. It does not without the grill member. That is obvious.

On page 57 discussion occurs as to what is meant by the flange extending past the edges of the casings. As the patent shows them extending beyond the outer edges, that is clearly what must be meant. Unless the flange goes beyond the *outer* edge, batter would adhere to the edge, which appellee says, *supra*, it must not.

On page 58, the absurd statement is made that defendant's device has insulation insulating the heating element from the casing. Any such insulation is done entirely by air space—not by insulation resting on the bottom of the casing as in Wright.

It is not necessary to differentiate further between the Wright specification structure and the totally different organization of defendant with its different performance and law of operation.

On pages 60, 61, appears a quotation from *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U. S. 405. Appellee very deftly terminated the quotation before a very significant sentence, which immediately follows, to-wit:—

“They may be explained and illustrated by the description. They cannot be enlarged by it.”

This clearly supports, with the authorities *supra* and in our opening brief, our contention that the claims cannot, in interpretation, go beyond the clear teaching of the description in the patent. It is *enlarging* the claims of the Wright patent to interpret them to cover

something abhorrent in operation to and totally different in structure from the “best” form of the invention explained and set forth in the description.

Robinson on Patents, Vol. II, Sec. 485, quoted with approval by the Supreme Court in this last cited case, further states in this connection:

“But one mode of reducing the idea to practical utility must be described, and this must be the best one known to the inventor, since to withhold, for his own use or that of the licensees, a better form than that which he bestows upon the public would be a fraud upon them and render the patent void.”

To ask the court to find something not disclosed in the patent, to be the principal and generic thing of the patent, is certainly doing violence to all rules of interpretation.

The authority cited by appellee on pages 62, 63 (171 Fed. 656, 663) clearly supports our contention that the base or grill member of the Wright patent may be read into the claims as part of the organization for pivotally connecting together the casings, for each of claims 6 to 9 “includes an element in general terms, and refers to the specification to identify it.” And so “We may read that element into the claim—a rule of construction applicable to all written instruments; * * *” The term “pivotally connected together” means and can only mean *pivotally connected together by means of the base or grill member or the frame thereof.*

In the same volume of Robinson, section 515, the following significant language is found:

“Finally, as the claim is the request of the inventor for the protection of the invention communicated to the public in the Description, it must entirely correspond with the Description and be based upon the matter therein contained. No invention can be claimed in any specification unless it has been previously described in such a manner that any person skilled in the art could practice it from such Description, without experiment or the exercise of his own inventive skill. Features of the invention not delineated in the Description cannot be inserted in the Claim, even though a mechanic in endeavoring to construct or employ the invention would inevitably discover them. Matter described as auxiliary, but not essential to the invention, cannot be stated in the claim.”

Clearly, experiment and invention would be required to produce appellee's structure and operation, with the different teaching of the Wright patent as a guide.

It appears from the record that all of appellant's procedure was justifiable, was made without knowledge of the Wright patent, followed in its structural details the prior practice of appellant (and Crompton and the aluminum baking surface of Griswold); and inasmuch as appellee's device never went on the market, but appellant took the field with the alleged infringing device, no case of piracy or any equitable ground for finding piracy in this case appears.

As to the rule of law limiting the patent in suit to the exact thing described and pictured, we repose

full confidence in this case in the position as often taken by this Honorable Court, as in *Henry v. Los Angeles*, 255 Fed. and *Schultheiss Co. v. Phillips, et al.*, 264 Fed., cited in our opening brief. The treatment of this subject on pages 69, 70, tends to cloud the issue in the case at bar, for under the authorities cited *supra*, as well as in our opening brief, all of the claims of the patent must be limited to the exact thing which the patentee has said is his invention. To the same effect is the decision of this court in *Wilson and Willard Mfg. Co. v. Union Tool Company*, 249 Fed., cited in our opening brief.

The excuses reflected at page 72, and directed at explaining why appellee did not put his alleged invention on the market, are unavailing. His complicated patent structure remains in oblivion, while appellant has given a different structure to the market—a structure which has been adopted and *which did not follow the path of Wright's mechanical procedure*. This last speaks volumes for appellant's contention of non-infringement. There was evidently nothing of commercial merit in the Wright patent structure. Surely, if appellant could manufacture in New England and ship its product across the continent and extensively market it on the Pacific coast, appellee, domiciled here, should be able to make a reasonable commercial showing here—*had his invention had commercial merit*. We venture to say that appellee has throughout this litigation been striving for an interpretation of claims 6 to 9 which, prior to the advent of appellant's production, he never seriously conceived such claims were entitled to,

and, judging his patent upon its face, we are inclined to reflect that the interpretation he is asking for as to these claims was built up in appellee's mind, and urged upon the lower court, to satisfy the exigencies of the situation after appellant's device appeared.

A reasonable deduction from the comparative conducts of appellant and appellee is that the appellee's patent is for a commercially unacceptable complicated thing, and that appellant gave to the market a really acceptable device, although from the standpoint of creation its whole organization had been previously worked out—not by Wright.

Henry v. Los Angeles, 255 Fed. *supra*, answers, as the utterance of this court, the authority on page 73 as to non-use, commercially, of the thing of the Wright patent, and non-use by appellee, commercially, of anything he now contends to be within the metes and bounds of that patent.

Crompton plus the Griswold aluminum waffle iron baking surface gave the accepted commercial device to the world, further plus the details which defendant's inventor, Lamb, produced. *All these things were prior to Wright.*

Appellant does not use any structure having the complex interrelation or law of operation or teaching of the Wright patent. If claims 6 to 9 are to be sustained—if they have any detail novelty whatsoever—the base or foundation or grill member a, one of the “principal parts” of the Wright invention as disclosed

and pictured in appellee's patent, must be read into said claims, as an essential part of the organization whereby the casings are "pivotally connected together." This is the *real* "precise machine described" and the trial court says the claims should be limited to the precise machine described. If they are not so limited, they recite inoperative construction. Defendant has not employed this "precise machine described" or anything having the clear and only teaching of the Wright patent, either in general combination or detail. It has ignored the teaching and the only teaching of the Wright patent.

Infringement cannot be predicated on any such condition of facts and the law pertinent thereto.

If the claims are construed so as to include defendant's device, they are clearly invalid and void for want of invention or novelty over Crompton and the other prior art; or, if sustained at all, they are not infringed by defendant's structure, because of the limitations of the prior art and of the patent itself and the file wrapper and contents thereof—and because they are for a different structure having an irreconcilably different mode of operation.

We again respectfully submit that the decree of the District Court should be reversed and the bill of complaint dismissed with costs to appellant.

Respectfully submitted,

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Of Counsel for Defendant-Appellant.

